

REMARKS

In the office action dated February 11, 2004, claims 1, 5-13, and 22-30 were rejected as directed to allegedly non-statutory subject matter. Claim 6 will apparently be rejected based on “same invention”-type double patenting or objected to under 37 C.F.R. 1.75 if claim 5 is found to be allowable. Claims 1-62 were rejected as being allegedly indefinite.

By this amendment, claims 60-62 have been canceled, and claims 1, 31, and 32 have been amended. Thus, after entry of this amendment, claims 1-59 remain pending.

Section 101 Rejections

Claims 1, 5-13, and 22-30 stand rejected under 35 U.S.C. § 101 as allegedly directed to non-statutory subject matter. The rejection states that a computer-related process must either be: A) a result of a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan, or B) be limited to a practical application within the technological arts.

Applicant respectfully traverses this rejection, in part, because the rejection assumes limitations that are simply not in all of these claims. The claimed invention of claims 1-11, 13-53, and 55-57 relates to a method of conducting a base game of chance and a bonus game of skill. Only claims 12, 54, 58, and 59 include or includes the use of an electronically-implemented form or a computer.

As to the alleged “computer-related” process distinction, *Alappat* (cited in the rejection) states that the plain and unambiguous meaning of section 101 is that any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may be patented if it meets the requirements for patentability set forth in sections 102, 103 and 112. The use of the expansive term “any” in section 101 represents Congress’ intent not to place any restrictions on the subject matter for which the patent may be obtained beyond those specifically recited in section 101 and other parts of Title 35. The Supreme Court has acknowledged that Congress intended section 101 to extend to anything

under the sun that is made by man. *See Diamond v. Chakrabarty*, 447 U.S. 303, 309. *In re Alappat*, 33 F.3d 1526, 1542.

There are only three categories of subject matter for which one may not obtain patent protection namely: 1) laws of nature; 2) natural phenomena; and 3) abstract ideas. *Alappat*, 33 F.3d at 1542. The Supreme Court also has held that certain mathematical subject matter is not, standing alone, entitled to patent protection. *see Diehr*, 450 U.S. 175; *Parker v. Flook*, 437 U.S. 584; *Gottschalk v Benson*, 409 U.S. 63. The Supreme Court never intended to create an overly broad fourth category of subject matter excluded from section 101. Rather, at the core of the Court's analysis in each of these cases lies an attempt by the court to explain a rather straightforward concept, namely, that certain types of mathematical subject matter standing alone, represents nothing more than abstract ideas until reduced to some type of practical application, and thus that the subject matter is not, in and of itself, entitled to patent protection. *Alappat*, 33 F.3d at 1543.

Even to the extent claims 12, 54, 58, and 59 are computer-related, these claims would not be unpatentable as directed to non-statutory subject matter. The invention as recited in claims 12, 54, 58, and 59 is not an abstract idea under *Alappat*. The claims have a practical application, namely providing a method wherein players have at least one opportunity to qualify for play of a bonus game during play of a base game of chance on an electronic or computer based apparatus. Reconsideration and withdrawal of the Examiner's rejections is requested.

Same Invention-Type Double Patenting Rejection

A rejection or objection also appears to be raised in regard to claim 6, apparently alternatively under "same invention"- type double patenting and 37 C.F.R. 1.75, although it is not clear on what basis the claim is rejected or objected to, if at all. Applying either standard, applicants submit that the claim is proper. As to the double patenting rejection, double patenting occurs when the right to exclude granted in a first patent is unjustly extended by grant of a later issued patent. See MPEP §804. This is not the circumstance here, because the claims at issue are in a single patent; therefore, a double patenting rejection may not be maintained. As to the objection under section 37 C.F.R. 1.75, MPEP 706.03(k) states that court decisions have confirmed an applicant's right to restate

(i.e., by plural claiming) the invention in a reasonable number of ways. Moreover, a mere difference in scope between claims has been held to be enough to overcome an objection under section 37 C.F.R. 1.75. Applicants submit that claim 6 is a subset of claim 5 and therefore includes a difference in scope, as such claim 6 should not be objected to under 37 C.F.R. 1.75.

Section 112 Rejections

Claims 1-62 are rejected under 35 U.S.C. §112, second paragraph, as allegedly indefinite. In response, the preambles of the independent claims have been amended to remove the reference to “conducting a game of chance” or “playing a game with a controller,” although by doing so the scope of the claims remains unchanged.

Claims 1, 31, and 32 are also rejected under 35 U.S.C. §112 because the examiner asserts that “each of the plurality of players” is not linked to steps/features of method/system for play in a bonus game. Claims 1, 31, and 32 have been amended to clarify the claimed invention and place the claims in proper form. The amendments to claims 1, 31, and 32, while helping to clarify the claimed subject matter, nevertheless do not change the scope of the claims.

Allowable Claims

It is noted that the Examiner indicated in the February 11, 2004 Office Action that claims 31-60 would be allowable if rewritten. However, claims 2-4 and 14-21 also were not rejected, so it appears claims 2-4 and 14-21 are also allowable.

It is respectfully submitted this Amendment traverses and overcomes all of the objections and rejections to the claims as originally filed. It is further submitted that this Amendment has antecedent basis in the application as originally filed, including the specification, claims, and drawings, and that this Amendment does not add any new subject matter to the application. Reconsideration of the claims, as amended, is requested.

If the Examiner feels that prosecution of this present application can be expedited by way of an Examiner's amendment or further communication, the Examiner is invited to contact the applicants' attorney at the telephone number listed below.

Dated: June 14, 2004

Respectfully submitted,

By Matthew D. Fair
Matthew D. Fair
Registration No.: 51,662
MARSHALL, GERSTEIN & BORUN LLP
233 S. Wacker Drive
6300 Sears Tower
Chicago, Illinois 60606-6357
(312) 474-6300
Attorney for Applicant